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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/768,062	04/27/2010	Stephen C. Wardlaw	7564-0007-1-1-1-1	4877

50811 7590 12/01/2016  
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EXAMINER
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TURK, NEIL N

ART UNIT	PAPER NUMBER
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1798

NOTIFICATION DATE	DELIVERY MODE
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12/01/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEPHEN C. WARDLAW

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Appeal 2015-005691  
Application 12/768,062  
Technology Center 1700

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Before ADRIENE LEPIANE HANLON, CATHERINE Q. TIMM, and  
JAMES C. HOUSEL, *Administrative Patent Judges*.

*PER CURIAM*.

DECISION ON APPEAL<sup>1</sup>

Appellant<sup>2</sup> filed an appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting, under 35 U.S.C. § 103(a), claims 1, 5, 6, 9, 10, and 22 as unpatentable over Vermeiden<sup>3</sup> in view of Hall,<sup>4</sup> and rejecting claim 22 as

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<sup>1</sup> Our decision refers to Appellant's Specification filed November 28, 2011 (Spec.), Appellant's Appeal Brief filed October 29, 2014 (Appeal Br.), the Examiner's Answer delivered March 12, 2015 (Ans.), and Appellant's Reply Brief filed May 12, 2015 (Reply Br.).

<sup>2</sup> Appellant identifies the real party in interest as Abbott Laboratories. Appeal Br. 3.

<sup>3</sup> Vermeiden et al., US 6,551,554 B1, issued April 22, 2003 ("Vermeiden").

<sup>4</sup> Hall et al., US 4,022,521, issued May 10, 1977 ("Hall").

unpatentable over Vermeiden and Hall and further in view of Smith.<sup>5</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

#### STATEMENT OF THE CASE

The subject matter on appeal relates to apparatus for enumerating elements within an anticoagulated human whole blood sample (*see, e.g.*, claim 1). Appellant discloses that the apparatus is simple, accurate, and relatively low in cost for performing blood cell counts, such as counts of red blood cells and white blood cells. Spec. ¶ 8. The apparatus includes a first planar member and a second planar member separated from one another by a substantially uniform height sized relative to the blood cells so the cells non-uniformly distribute within a blood sample upon introduction into a chamber, which is provided between the planar members. *Id.* at ¶ 9. The planar members may be flexible and separator elements may be disposed between the planar members. *Id.* at ¶¶ 22, 25. Appellant explains that capillary forces may cause the separator elements or a planar member to deform so the chamber produced between the planar members assumes an accurate mean chamber height. Appeal Br. 8. The mean chamber height results in the non-uniform distribution of white blood cells and red blood cells within a sample introduced into the chamber. *Id.*

Independent claim 1 is illustrative and is reproduced below from the Claims Appendix of the Appeal Brief.<sup>6</sup> The limitations at issue are italicized.

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<sup>5</sup> Smith, US 4,950,455, issued August 21, 1990 (“Smith”).

<sup>6</sup> Appeal Br. 11.

1. An apparatus for enumerating elements within an anticoagulated human whole blood sample that includes white blood cells and red blood cells, comprising:

a chamber defined by a first planar member that is transparent, a second planar member, and a plurality of separator elements disposed between the first planar member and the second planar member, which separator elements are independent of the first planar member and the second planar member and each of which has a height, and *wherein one of the first planar member and separator elements are deformable relative to the other by capillary force in an amount that the chamber assumes a mean chamber height substantially equal to a mean separator height*; and

one or more sidewalls extending between the first planar member and the second planar member;

wherein the planar members are separated from one another by a substantially uniform chamber height of about 4 microns, and the chamber height is such that it causes white blood cells and the red blood cells within the sample to non-uniformly distribute within the sample upon introduction into the chamber.

#### ANALYSIS

The dispositive issue on appeal is whether Appellant has shown a reversible error in the Examiner's finding that Vermeiden discloses a first planar member that is deformable, as recited in claim 1.

Appellant has persuaded us of such an error.

Appellant contends Vermeiden does not disclose that one of its top plate **3**<sup>7</sup> and particles **8** are deformable relative to the other by capillary force in an amount that a chamber assumes a mean chamber height substantially equal to a mean separator height, as recited in claim 1. Appeal Br. 7.

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<sup>7</sup> Throughout this Opinion, for clarity, we present labels to elements in figures in bold font, regardless of their presentation in the original document.

The Examiner finds Vermeiden discloses a first planar member that is deformable, citing the top plate **3** as deformable relative to the particles **8**.  
Ans. 3. In response to Appellant's arguments, the Examiner finds the top plate **3** of Vermeiden "is made of a material, such as glass, which is deformable relative to the separator elements **8**." Ans. 6.

As argued by Appellant, these findings are not sufficient to support the Examiner's rejection. Reply Br. 1. To the extent the Examiner finds the top plate **3** is simply deformable, as stated at pages 3 and 6 of the Answer, claim 1 recites the deformation is "by capillary force." Claim 1 recites, *inter alia*, "wherein one of the first planar member and separator elements are deformable relative to the other by capillary force in an amount that the chamber assumes a mean chamber height substantially equal to a mean separator height." Claim 1 does not merely require that one of the first planar member and separator elements is deformable, but that such deformation occurs by capillary force and in a specified amount. Therefore, the Examiner's finding that the top plate **3** is deformable fails to fully address the recitations of claim 1, and is insufficient to support the Examiner's rejection.

Moreover, the Examiner's findings at page 6 of the Answer that claim 1 does not require an active application of capillary force or an active step of deformation do not properly consider the scope of claim 1. As stated above, claim 1 requires one of the first planar member and separator elements to be "deformable relative to the other by capillary force." An attempt to parse the language of claim 1 so as to ignore the requirement that one of the first planar member or separator elements of claim is deformable by capillary force is not a proper construction of the recitations of claim 1. While claim

1 does not recite an active step of the application of capillary force, this claim nonetheless recites a structural property of one of the planar members and the separator elements that determines how that member or element functions. It is not proper for the Examiner to ignore any positively recited structural property of a claim. The reasonable construction of the limitation at issue here is that one of the first planar member and separator elements is deformable relative to the other by capillary force.

The Examiner further finds that:

Vermeiden provides to disclose a first planar member **3** that is made of glass, which is a material that is capable of being deformed relative to separator elements given an applied amount of capillary force so as to assume a mean chamber height substantially equal to a mean separator height (as likewise disclosed by Vermeiden), in as much as Appellant as claimed.

*Id.* at 6–7.

To the extent the Examiner finds the top plate **3** of Vermeiden is capable of being deformed by capillary force, a preponderance of the evidence in the record does not support this finding. The Examiner provides no evidence in the record or technical reasoning to support the finding that the glass top plate **3** would deform by capillary force. Moreover, Vermeiden’s disclosure relative to the top plate **3** provides no further support for the Examiner’s findings. Vermeiden discloses:

The top and bottom plate are preferably both made of a material which transmits UV and/or visible light, preferably glass, and the top plate should be selected to be as thin as possible in order to facilitate the examination by means of a microscope.

Vermeiden col. 2, ll. 11–15.

Thus, Vermeiden discloses the top plate **3** may be made of glass and is as thin as possible to facilitate optical examination via a microscope. However, Vermeiden is silent with regard to making the top plate **3** sufficiently thin so as to be deformable by capillary force.

In view of the above, the disclosure of Vermeiden does not provide a factual basis to support the Examiner's finding that Vermeiden discloses one of a first planar member and separator elements is deformable relative to the other by capillary force, as recited in claim 1. Therefore, Appellant has demonstrated a reversible error in the Examiner's finding that Vermeiden discloses a first planar member that is deformable by capillary force, as recited in claim 1.

Claims 5, 6, 9, 10, and 22 depend from claim 1. For the reasons set forth above, the rejection of claims 1, 5, 6, 9, 10, and 22 under § 103 over Vermeiden in view of Hall is not supported by the record and is not sustained.

The remaining § 103 rejection of claim 22 over Vermeiden and Hall and further in view of Smith suffers from the same deficiencies as the §103 rejection of claim 1. Although the remaining § 103 rejection includes Smith as an additional prior art reference, the Examiner does not rely on Smith to remedy the above-discussed deficiencies in the combination of Vermeiden and Hall. Therefore, we likewise do not sustain the Examiner's § 103 rejection of claim 22 over Vermeiden, Hall, and Smith.

Appeal 2015-005691  
Application 12/768,062

DECISION

On the record before us and for the reasons given in Appellant's Appeal and Reply Briefs, we *reverse* the Examiner's § 103 rejections.

REVERSED